



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/797,215

03/09/2004

Loc X. Phan

018563-001550US

4185

46718

7590

11/19/2009

TOWNSEND AND TOWNSEND AND CREW, LLP (018563)
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

PATEL, YOGESH P

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

11/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Drawings

The replacement drawings received on 09/24/2009 have been entered.

Specification

The amendment to the specification filed 09/24/2009 is acknowledged and entered.

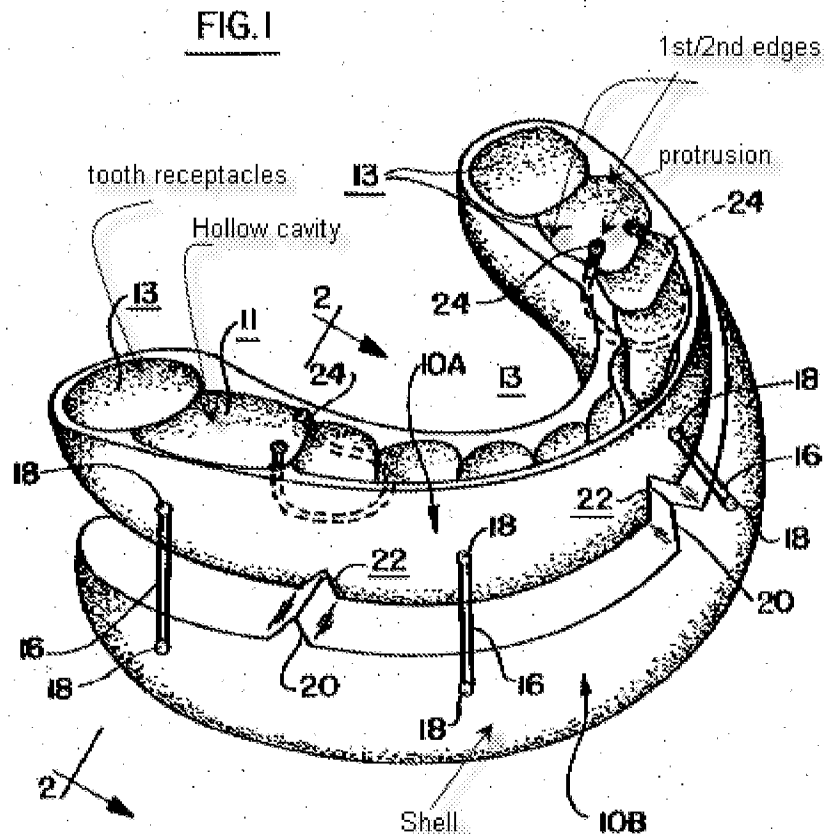
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 28, 29, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 4,505,672) in view of Cathcart (US 2,643,652).

Kurz discloses a removable positioner including a shell (fig. 1) having a hollow cavity with first and second edges shaped to receive and position teeth and a protrusion as shown below. Kurz does not show the claimed continuous protrusion.



Cathcart for a similar removable elastic appliance (fig. 4) teaches the use of a continuous protrusion 10 in order to provide "excellent anchorage" within the user's mouth (note column 3, lines 53-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kurz by providing continuous protrusion as taught by Cathcart in order to effectively hold the appliance within mouth.

Cathcart shows the protrusion is being embedded/integral in the appliance, but fails to show it is adhered to the appliance. However, it would have been an obvious

Art Unit: 3732

matter of design choice to one skilled in the art at the time the invention was made to adhere the protrusion to the appliance since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configuration a person of ordinary skill in the art would find obvious for the purpose of providing retention of the appliance in the mouth. In re Dailey and Eilers, 149 USPQ 47 (1966). Furthermore, adhering the protrusion to the appliance or it being embedded in the device for its retention purpose are art equivalent, and therefore it would be within the level of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3732

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH PATEL whose telephone number is (571)270-3646. The examiner can normally be reached on 8:00 to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YOGESH PATEL/
Examiner, Art Unit 3732

/Ralph A. Lewis/
Primary Examiner, Art Unit 3732